Chapter V

Exporting Trademark Confusion

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ABSTRACT

A judicial determination of “likelihood of confusion” is the linchpin of successful trademark infringement actions in the United States, and is often useful to prevail on a trademark dilution cause of action as well. Such determinations are exceedingly subjective, and often seem premised on a very low estimation of the intelligence and powers of discernment of the typical consumer. Many appear virtually pretextual, simply adopted as a necessary step in “protecting” trademarks and according trademark holders broad property-like rights that can impair competition and silence free speech. Though seemingly irrational and generally socially undesirable, U.S. “likelihood of confusion” jurisprudence has gained a foothold in cyberspace through dispute-resolution procedures addressing disputes about Internet domain names. In consequence, trademark holders generally prevail and are increasingly seen as holding inchoate rights in any domain name containing, alluding to, or similar to their trademarks across the globe, even though U.S. trademark law logically should not have extraterritorial application.
EXPORTING TRADEMARK CONFUSION

“Likelihood of confusion” among consumers is the evil that a large segment of U.S. trademark law and jurisprudence is intended to guard against. In addition to stopping and punishing activities by others that are objectionable to trademark holders, successful outcomes in trademark infringement and trademark dilution cases discourage third parties from using trademarks of their own in commerce that are even mildly similar, and dissuade others from making arguably legally permissible uses of the trademark itself. In the context of such litigation, trademark holders will generally assert that consumers are easily confused because judicial acceptance of this assumption always helps them prevail in trademark infringement suits. Assertions of consumer confusion are sometimes useful in winning trademark dilution actions as well. While dilution claims are generally understood not to require proof of actual or likely consumer confusion, raising the possibility of confusion or concepts very much like it (such as the “danger of false assumptions”) is often analytically useful to trademark holders.

The meaning of “likelihood of confusion” has taken on surprising and alarming dimensions in cyberspace where it has become a rhetorical device used to grant trademark holders rights to domain names that incorporate or even vaguely insinuate vigorously protected trademarks. Domain name jurisprudence, like the Internet that spawned it, touches every corner of the earth, so the form and texture of the trademark rights it fabricates may spread internationally as well.

INFRINGEMENT AND DILUTION IN THE U.S.: POWERFUL LIKELIHOOD OF CONFUSION

In most applications of U.S. trademark law, context is everything. For example, whether a word can even function as a protectable trademark can only be determined in the context of the good or service with which it is used in conjunction. The trademark taxonomy is generally deemed to contain four categories: generic, descriptive, suggestive, and arbitrary or fanciful.\footnote{_Generic_}

**Generic**

Words that are generic with respect to the associated product or service can never be protected as trademarks because this would be unfair to
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